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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,885	10/08/2004	Oskar Pacher	PACHER	6308
<div>20151      7590      06/06/2007</div> <div>HENRY M FEIEREISEN, LLC</div> <div>350 FIFTH AVENUE</div> <div>SUITE 4714</div> <div>NEW YORK, NY 10118</div>				
			EXAMINER	
			ZHU, WEIPING	
			ART UNIT	PAPER NUMBER
			1742	
			MAIL DATE	DELIVERY MODE
			06/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/510,885	<b>Applicant(s)</b> PACHER ET AL.	
	<b>Examiner</b> Weiping Zhu	<b>Art Unit</b> 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 15-17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15-17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/8/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

The application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.4999, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted

- I. Claims 1-7, 15-17 and 20, drawn to ferritic chromium steel;
- II. Claims 8-14, 18 and 19, drawn to a process for improving the spring properties of material in strand form.

The inventions listed as I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature in Invention I is the composition of the ferritic chromium steel with specific composition and grain size requirements, which is not the special technical feature in Invention II. The special technical feature in Invention II is the process for improving the spring properties of material in strand form requiring the process steps of cold-working, solution-annealing, quenching, hot age-hardening and final annealing, which are not present in Invention I. Inventions I and II lack the same or corresponding special technical features. Therefore unity of invention is lacking and restriction is appropriate.

During a telephone conversation with Mr. Henry M. Feiereisen on May 29, 2007 a provisional election was made without traverse to prosecute the invention of I, claims

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1-7, 15-17 and 20. Affirmation of this election must be made by the applicant in replying to this Office action. Claims 8-14, 18 and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should the applicant traverse on the ground that the inventions are not patentably distinct, the applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

The applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,083,237 A2.

With respect to claims 1, 2, 15 and 17, EP ('237 A2) discloses a ferritic chromium steel comprising the elements with the content ranges (paragraphs [0043]-[0067], pages 6-8) listed in the table below.

Elements	EP ('237 A2) (wt%)	Instant Claim 1 (wt%)	Overlapping Ranges
C	0.001-0.12	0.03-0.1	0.03-0.1
Si	0-1.0	0.2-0.9	0.2-0.9
Mn	0-1.0	0.3-1.0	0.3-1.0
Cr	9-32	13-20	13-20
Ni	0-1.0	Less than 0.5	Less than 0.5
Mo	0-2.5 (with Cu)	0.1-1.5	0.1-1.5
Cu	0-2.5 (with Mo)	0.1-0.5	0.1-0.5
N	0.001-0.12	0.03-0.05	0.03-0.05
B	0.0002-0.003	Less than 0.001	Less than 0.001
Ti	0-0.5	Less than 0.01	Less than 0.01
Nb	0-0.5	0.01-0.10	0.01-0.10
V	0-0.15	0.02-0.25	0.02-0.15
Al	0-0.03	Less than 0.002	Less than 0.002
Fe	Balance	Balance	

The composition of the ferritic chromium steel of EP ('237 A2) completely overlaps the claimed composition. A prima facie case of obviousness exists. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the claimed ranges of the elements within the disclosed

ranges of EP ('237 A2) with expected success, because EP ('237 A2) discloses the same utility over the entire disclosed ranges.

The feature of "as a material for a corrosion –resistant spring element" in the instant claim 1 is interpreted as an intended use and gives no patentable weight to the claim. See MPEP 2111.02 II.

With respect to claims 3 and 4, the composition of EP ('237 A2) clearly satisfies the claimed equations, because the content ranges of C, N, Nb, V and Ti of EP ('237 A2) overlap the corresponding claimed ranges. Furthermore it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

With respect to claims 5, 6 and 16, EP ('237 A2) discloses that the ferritic chromium steel has good ductility and formability and also has excellent anti-ridging properties (paragraph [0016], page 3). EP ('237 A2) further discloses the process to make the ferritic chromium steel (paragraphs [0068]-[0084], pages 8-10), which is substantially identical to the process of the instant invention. EP ('237 A2) does not disclose the claimed features in the instant claims 5, 6 and 16. However, it has been well held where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical

process, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), MPEP 2112.01 [R-3] I. In the instant case, the claimed and EP ('237 A2)'s ferritic chromium steels are identical or substantially identical in structure or composition and are produced by identical or substantially identical processes, therefore a prima facie case of obviousness exists. The same metastable state, the same dimensional stability and the same grain size would be expected in the ferritic chromium steel of EP ('237 A2) as in the claimed ferritic chromium steel.

With respect to claim 7, the statement "for fabricating leaf spring, ....." in the instant claim 7 is interpreted as an intended use and gives no patentable weight to the claim. See MPEP 2111.02 II.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP ('237 A2) in view of JP 2001-123248 A.

With respect to claim 20, EP ('237 A2) teaches the substantially similar ferritic chromium steel as claimed, see the paragraph 2 above. EP ('237 A2) does not teach a spring element made of the ferritic chromium steel as claimed.

JP ('248 A) discloses a spring made of ferritic chromium steel (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a spring element with the ferritic chromium steel of EP ('237 A2) as disclosed by JP ('248 A) with expected success, because both steels of EP ('237 A2) and JP ('248 A) are the ferritic chromium steels with similar compositions as

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disclosed by EP ('237 A2) (paragraphs [0043]-[0067], pages 6-8) and JP ('248 A) (abstract).

**Conclusion**

4. This Office action is made non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WZ

5/30/2007

ROY KING  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700